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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Benoit P. Menez, et al.
Serial Number: 09/745,205
Atty. Docket: PU000178
Filing Date: December 21, 2000
For: CONTROL SPENDING BASED ON TIME PERIOD
Art Unit: 3621
Examiner: Kambiz Abdi

APPEAL BRIEF

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Sir:

In response to the final rejection of July 26, 2005, and further to the Notice of Appeal filed on October 26, 2005, Appellants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

I. Real Party in Interest

The real party in interest is Thomson Licensing Inc.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-4 and 11-12 are pending in this application, and are rejected. Claims 5-10 and 13 have been previously cancelled. The rejection of claims 1-4 and 11-12 is being appealed.

IV. Status of Amendments

An amendment subsequent to final rejection has been filed on September 2, 2005, and has been entered. Based on the Advisory Action of October 12, 2005, Appellants' presume that the previous rejection of claims 1-4 under 35 U.S.C. §101 has been withdrawn responsive to the amendment of September 2, 2005.

V. Summary of Claimed Subject Matter

The claimed subject matter relates to a method, system and television apparatus for controlling user spending of a user purchasing television programs. According to an exemplary embodiment, the method includes electronically detecting a first user request (see page 15, lines 1-5, and step 601 of FIG. 6). In response to the first user request, a plurality of selectively actuatable entries is electronically provided for user spending limits, with each entry being associated with a different-length time period (see FIG. 8). A user may select at least one of the entries and a spending limit for each selected entry (see page 15, lines 23-27, and step 611 of FIG. 6). If more than one of the entries is selected, a determination is made as to whether the spending limit for a shorter time period is greater than the spending limit for a longer time period (see page 15, lines 28-

32, and step 613 of FIG. 6). A user warning is electronically provided if the spending limit for the shorter time period is greater than the spending limit for the longer time period (see page 15, lines 32-33, and step 615 of FIG. 6). A second user request to purchase a television program during the time period associated with each selected entry is electronically tracked (see page 15, line 34 to page 16, line 1, and steps 617 and 625 of FIG. 6). In response to the second user request, the user is electronically notified if purchasing the requested television program would exceed the spending limit during the time period for any selected entry (see page 16, lines 1-3, step 621 of FIG. 6, and FIG. 9). The claimed system and television apparatus are operative to perform the foregoing steps via means corresponding to elements of a control program executed by CPU 1112 of FIG. 2, controller 115 of FIG. 3, and/or ARM microprocessor 315 of FIG. 4 (see page 14, lines 28-33).

VI. Ground of Rejection to be Reviewed on Appeal

The rejection of claims 1-4 and 11-12 under 35 U.S.C. § 103(a) based on Smith (U.S. Patent No. 5,559,871) in view of Uraskoshi et al. (U.S. Patent No. 6,067,564), and further in view of Stodghill et al. (U.S. Patent No. 5,701,901) is presented for review in this appeal.

VII. Argument

The rejection of claims 1-4 and 11-12 under 35 U.S.C. § 103(a) based on Smith '871 in view of Uraskoshi et al. '564, and further in view of Stodghill et al. '901 should be reversed since the rejection is clearly based on impermissible hindsight reconstruction. As will be explained hereinafter, this impermissible hindsight is evidenced by the fact that one of ordinary skill in the art would not be motivated to combine the prior art references in the manner proposed by the Examiner.

It is first noted that the claimed invention relates to a method, system and television apparatus for controlling user spending of a user purchasing **television programs**. Of the three prior art references applied in the instant rejection, only one of those references, namely secondary reference Urakoshi et al. '564, even relates to the

field of television art. The primary reference, Smith '871 relates to the field of telephonic communications (i.e., Class 379), and the other secondary reference, Stodghill et al. '901, relates to the field of data processing and validation (i.e., Class 395). Accordingly, the fact alone that the Examiner selectively applies prior art from three distinctly different fields of art initially suggests that the appealed rejection is based on impermissible hindsight reconstruction using the Appellants' disclosure as a blueprint for formulating the rejection.

The aforementioned impermissible hindsight reconstruction is further evidenced by the Examiner's proposed combination of Smith '871 and Urakoshi et al. '564. In particular, to support the rejection appealed herein, the Examiner proposes modifying the telephone call charge control technique disclosed by Smith '871 in accordance with the television program purchase control technique of Urakoshi et al. '564. This proposed combination is flawed in that one of ordinary skill in the television art would not be motivated to even look to telephonic communication art in order to solve the problem of controlling user spending for purchasing television programs. One primary reason for this lack of motivation is that the problem of controlling user spending for purchasing television programs, as claimed, is very different than the problem of controlling telephone call charges due to the inherent differences between television program purchase charges and telephone call charges. In particular, television program purchase charges are known before program purchase and viewing occur, while telephone call charges are known only after a call is completed. For example, a user contemplating the purchase of a pay-per-view television program is typically advised of the cost of this purchase before the purchase is actually made. Conversely, a user contemplating a long distance telephone call does not necessarily know the cost of the call before the call is commenced since he/she does not necessarily know how long the call will last. Given this fundamental difference in the nature of television program purchase charges versus telephone call charges, one of ordinary skill in the television art would not be motivated to use telephonic communication art to solve the problem of controlling user spending for purchasing television programs. Accordingly, this lack of motivation to modify the telephone call charge control technique disclosed by Smith

'871 in accordance with the television program purchase control technique of Urakoshi et al. '564 further evidences the impermissible hindsight reconstruction used to formulate the rejection appealed herein.

In the Advisory Action of October 12, 2005, the Examiner responds to the foregoing argument by stating:

"The applicant's argument in regards to permissibility of combination of prior art as presented in the rejection has been noted. However, the applicant is err in this characterization of the office action and the combination of prior arts as well as the motivation to combine. As it has been clearly stated by the applicant in the specification the thrust of the invention is 'the present invention allows a user to specify a spending limit that is based on a selected period, instead of or in addition to per event basis' (Specification Page 1). As well as, the applicant is specifically concerned with solving the problem of controlling the spending limits. ***So the main concern of the invention is the control of the spending, not the specific system that it is used by.***" (emphasis added)

The foregoing statement mischaracterizes the claimed invention. In particular, the foregoing statement attempts to use the specification, rather than the claims, to define the metes and bounds of the invention. In response, Appellants' note that independent claims 1, 11 and 12 clearly define a method (see claim 1), system (see claim 11) and television apparatus (see claim 12) "for controlling user spending of a user purchasing ***television programs.***" Accordingly, the claimed invention is clearly concerned with systems and apparatuses capable of receiving television programs and the problems related to controlling user spending when purchasing television programs, not simply controlling any type of spending in a generic sense, as indicated by the Examiner.

In the Advisory Action of October 12, 2005, the Examiner further states:

"The art used in the rejection of the claims under 35 U.S.C. §103 might not be in the same exact environment as the applicant's claimed [sic, invention], however, the problem stated by the applicant is the same as the prior art has resolved. As per above discussion the art used by the

examiner is correctly sighted and is permissible to be used in a 35 U.S.C. 103 rejection of the currently presented claims based on the ***applicant's proposed claimed language as to be related to a method and system for controlling user spending.*** (emphasis added)

Again, the Examiner mischaracterizes the claimed invention and selectively ignores the fact that independent claims 1, 11 and 12 clearly define a method, system and television apparatus "for controlling user spending of a user purchasing ***television programs.***" Moreover, and most significantly, the Examiner fails to address Appellants' previously stated argument explaining the inherent differences between the problem of controlling user spending for purchasing television programs, as claimed, and the problem of controlling telephone call charges addressed by primary reference Smith '871. As previously indicated, one of ordinary skill in the television art would not be motivated to even look to telephonic communication art such as Smith '871 in order to solve the problem of controlling user spending for purchasing television programs given the inherent and significant differences between television program purchase charges and telephone call charges.

The impermissible hindsight reconstruction used in the appealed rejection is further evidenced by the Examiner's reliance on Stodghill et al. '901. In particular, Stodghill et al. '901 discloses a technique for validating data entered into a computer database by a user. By way of example, Stodghill et al. '901 teaches that their system can be used to address invalid date entries, such as an entry of December 32 (see column 4, lines 35-41), or to check if all of the figures in a particular column of a computer spreadsheet add up correctly (see column 5, lines 2-4). Nowhere do Stodghill et al. '901 disclose that their system could be used to solve the problem of controlling user spending for purchasing ***television programs***, as claimed. In fact, Stodghill et al. '901 nowhere even mentions television programs, television apparatuses, or anything relating to television art. The term "television" is not present anywhere in the entire document. Accordingly, one of ordinary skill in the television art would have no motivation to consider the teachings of Stodghill et al. '901 when addressing the problem of controlling user spending for purchasing television programs.

For the reasons stated above, Appellants respectfully request that the Board reverse the rejection of claims 1-4 and 11-12 under 35 U.S.C. § 103(a) based on Smith '871 in view of Uraskoshi et al. '564, and further in view of Stodghill et al. '901.

VIII. Claims Appendix

1. A method for controlling user spending of a user purchasing television programs in a television apparatus, comprising the steps of:

electronically detecting a first user request;

electronically providing a plurality of selectively actuatable entries for user spending limits with each entry being associated with a different-length time period, in response to the first user request;

electronically receiving user selection of at least one of the entries and a spending limit for each selected entry;

electronically determining if the spending limit for a shorter time period is greater than the spending limit for a longer time period if more than one of the entries is selected;

electronically providing a user warning if the spending limit for the shorter time period is greater than the spending limit for the longer time period;

electronically tracking a second user request to purchase a television program during the time period associated with each selected entry; and

electronically notifying the user in response to the second user request, if purchasing the requested television program would exceed the spending limit during the time period for any selected entry.

2. The method of claim 1 further comprising the step of electronically providing a selection for a rolling time period.

3. The method of claim 1, wherein the electronically notifying step comprises the step of electronically generating a user warning.

4. The method of claim 3, further comprising the step of electronically allowing the user to override the user spending limit.

11. A system for controlling user spending of a user purchasing television programs, comprising:

means for providing a plurality of selectively actuatable entries for user spending limits with each entry being associated with a different-length time period, in response to a first user request;

means for receiving user selection of at least one of the entries and a spending limit for each selected entry;

means for determining if the spending limit for a shorter time period is greater than the spending limit for a longer time period if more than one of the entries is selected, and for providing a user warning if the spending limit for the shorter time period is greater than the spending limit for the longer time period;

means for tracking a second user request to purchase a television program during the time period associated with each selected entry; and

means for notifying the user in response to the second user request, if purchasing the requested television program would exceed the spending limit during the time period for any selected entry.

12. A television apparatus for controlling user spending of a user purchasing television programs, comprising:

a user interface for receiving a first user request;

means for providing a plurality of spending limit entries for a single user with each entry corresponding to a different length time period, in response to the first user request;

means for receiving user selection of at least one of the spending limit entries and a spending limit for each selected spending limit entry;

means for determining if the spending limit for a shorter time period is greater than the spending limit for a longer time period if more than one of the spending limit

entries is selected, and for providing a user warning if the spending limit for the shorter time period is greater than the spending limit for the longer time period;

means for tracking a second user request to purchase a television program during each different time period for which a spending limit was received; and

means for notifying the user in response to the second user request, if purchasing the requested television program would exceed the spending limit during the time period for any selected entry.

IX. Evidence Appendix

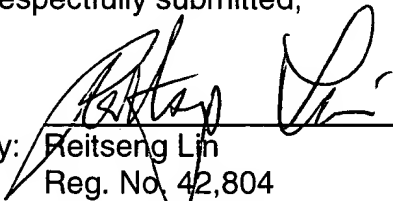
None.

X. Related Proceedings Appendix

None.

Please charge the fee for this Appeal Brief to Deposit Account 07-0832.

Respectfully submitted,


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December 19, 2005

CERTIFICATE OF MAILING

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop Appeal Brief, Commissioner for Patents, Alexandria, Virginia 22313-1450 on:

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